



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/285,809	04/01/99	CHEN	J 34

JOHN Y CHEN
APPLIED ELASTOMERICS INC
163 W HARRIS AVENUE
SOUTH SAN FRANCISCO CA 94080

IM62/1121

EXAMINER

HARLAN, R

ART UNIT

PAPER NUMBER

1713

DATE MAILED:

11/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/285,809

Applicant(s)

CHEN, JOHN Y

Examiner

Robert D. Harlan

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: on page 16, the formulae and reaction are confusing.

Appropriate correction is required.

Drawings

In the Specification, the Description of the Drawings section is formatted incorrectly. Each drawing sheet and figure should be described separately.

The drawings filed on April 1, 1999 are approved by the Draftsperson under 37 CFR 1.84 or 1.152.

Claim Objections

Claim 1 is objected to because of the following informalities:

Art Unit: 1713

- a. The Applicant uses the following language: wherein said elastomeric blocks comprises, this language does not have subject/verb agreement;
- b. "25oC" should read --25°C--;
- c. In claim 3 replace "DCS" with --DSC--;
- d. In claim 3, replace the first "25°C" with --20°C--.
- e. In claims 3, revise the "melting endotherm" limitation to read --greater than 20°C--;
- f. All the dependents have objectionable preambles. First, in claims 2-4, it is not a "non-tacky gel according to claim 1," but a non-tacky gel --composition-- according to claim 1. Second, in claims 5-9, the preamble should read in each claim --an improved non-surface activated, non-tacky gel composition according to claim 1-- wherein the composition is used as a composite, prosthetic device, face mask, dental floss, etc. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1713

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The Applicant uses the following language (lines 2-3):
multiblock and random copolymers having one or more glassy blocks and one or more elastomeric blocks. This language is indefinite because it is impossible by definition for a random copolymer to have glassy or elastomeric blocks.

b. The Applicant uses the following language (line 6):
said glassy components selected from polystyrene. First, there is insufficient antecedent basis for this limitation in the claim. Second, this language is an improper Markush format. See MPEP 2173.05 (h). It is suggested the Applicant insert --the group consisting of-- after "selected from."

c. The Applicant uses the following language (line 7):
wherein the amounts of glassy to elastomeric components (emphasis added). There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1713

d. The Applicant uses the following language (lines 8-9): wherein the amounts of glassy to elastomeric components of said copolymers forming said gels having a ratio (a) of at least 37:63 with the proviso that in the event said ratio (a) being less than 37:63 (Emphasis added). This is clearly indefinite language. The Applicant has established a ratio for the glassy to elastomeric components; however, the Applicant uses a provision to cover a ratio outside what the Applicant considers to be the invention. The Applicant cannot use provisional language that is outside the claimed limitations. A person of ordinary skill would not know if the claimed limitation or the provision was the invention since both assert contradictory limitations.

e. The Applicant uses the following language (lines 9-10): a selective amounts of (II) one or more glassy homopolymers selected from polystyrene. First, the language a selected amounts is objectionable and tantamount to saying "a cars" or "a selected pressures." Second, the language is an improper Markush format. See MPEP 2173.05

(h). It is suggested the Applicant insert --the group consisting of-- after "selected from."

Art Unit: 1713

f. The Applicant uses the following language (lines 11 and 12): said glassy homopolymer (emphasis added). There is insufficient antecedent basis for this limitation in the claim.

g. The Applicant uses the following language (line 15): compatible plasticizer. The Examiner does not know what the Applicant means by "compatible." The Applicant has not defined the term "compatible" in the specification and persons of ordinary skill in the art may differ.

h. The Applicant uses the following language (lines 17-18): said gel being formed with or without a major or minor amounts of (III) one or more selected copolymers or polymers (emphasis added). What does "without a major or minor amount" mean? This language is redundant, confusing and lacks a proper Markush format. It is suggested that the Applicant delete the entire clause.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "glassy associated phase resins" is

indefinite because the language is not defined in the specification and ambiguous to one of ordinary skill in the art.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "capable" is indefinite. Either the crystalline components exhibit an endotherm or they do not exhibit an endotherm. Furthermore, "said crystalline component" lacks an antecedent basis.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language . . . is formed in combination with or without a selected amount of one or more polymer or copolymer or . . . is confusing (emphasis added). Either the copolymer is formed in combination with the selected copolymers and polymers or the claimed should not be written because combining a positive limitation ("with") with a negative limitation ("without") is confusing. Also place the claim in a proper Markush format. See MPEP 2173.05 (h).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Makowski et al., U.S. Patent No. 3,821,149 (hereinafter "Makowski").

Makowski discloses plasticized thermoplastic semicrystalline block copolymers. See Makowski, Abstract; col.

Art Unit: 1713

2, lines 3-32. Makowski discloses polyethylene/polystyrene block copolymers and an assortment of plasticizers. See Makowski col. 6, line 28 through col. 8, line 33. Makowski discloses the crystalline polyethylene should have a molecular weight of preferably from 10,000 to 250,000. See Makowski, col. 4, lines 34-45. In working example 1, Makowski prepares a polyethylene-polystyrene-polyethylene block copolymer wherein a DSC showed a glass transition of 104°C and a melting transition of 87°C. See Makowski, col. 10, lines 61-68. The semi-crystalline block copolymers prepared by Makowski have several uses such clear films, hose, tubing, etc. See Makowski, col. 9, lines 47-58. Although Makowski does not disclose all the properties of present claim 1, (gel rigidities and tack), based on the type of block copolymer and plasticizers disclosed in Makowski, the Examiner has a reasonable basis to believe that properties claimed in the present invention is inherent in the block copolymers disclosed by Makowski. Because the PTO has no means to conduct analytical experiments, the burden of proof is shifted to the Applicants to prove that the properties are not inherent. See In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Best, 195 USPQ 430 (CCPA 1977).

Art Unit: 1713

Even if the disclosure of Makowski does not satisfy the requirements of 35 USC 102(b), it would have been obvious to one of ordinary skill in the art to arrive at the claimed gel composition, because it appears that the components of the claimed gel composition is within the generic disclosure of Makowski and a person of ordinary skill in the art would have expected all embodiment of Makowski to have similar properties. Furthermore, gel compositions have many uses that are known to persons of ordinary skill in the art. The Applicant claimed use of the gel composition as composite, prosthetic device, face mask, etc. is well within the art for gel compositions. Applicant has not demonstrated that the differences, if any, between the claimed compositions and the compositions disclosed by Makowski give rise to unexpected results. The evidence presented to rebut the prima facie case of obviousness must be commensurate in scope with the claims to which it pertains. See In re Dill and Scales, 202 USPQ 805 (CCPA 1979).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D.

Application/Control Number: 09/285,809
Art Unit: 1713

Page 11


Harlan whose telephone number is (703) 306-5926. The examiner can normally be reached on Mon-Fri, 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-3429 for regular communications and (703) 306-3429 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1495.

Robert D. Harlan
Examiner
Art Unit 1713

rdh
November 16, 2000


DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700